



Eric W. Lee

Partner

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OVERVIEW

Eric Lee concentrates his practice on trademark, copyright, patent, and other complex intellectual property litigation. He also counsels clients regarding their intellectual property portfolio development through the creation, development, and leveraging of trademarks and copyright. Eric manages global trademark portfolios, enforcement programs, and branding strategies, and is experienced with trademark clearance, prosecution, licensing, and due diligence. He works with clients in a variety of industries including e-commerce, fashion, music, travel, software, medical devices, and pharmaceutical.

PROFESSIONAL BACKGROUND

Eric was a summer associate at K&L Gates in 2013. He also has experience as a Law Clerk at a Massachusetts-based legal advocacy center.

ACHIEVEMENTS

- Listed as “One to Watch” by *Best Lawyers in America*®, 2023
- Listed as a “Rising Star” by *Managing IP Magazine*, 2023
- Recognized by *The Legal 500 United States* as a Recommended Lawyer for Intellectual Property, Trademarks: Non-Contentious (Including Prosecution, Portfolio Management And Licensing), 2023

SPEAKING ENGAGEMENTS

- Patent and Intellectual Property Basics for University Entrepreneurs, Wentworth Institute of Technology, Accelerate Innovation and Entrepreneurship Center, Boston, MA, February 14, 2023

ADDITIONAL BACKGROUND

Eric is an accomplished string musician having previously played in the Boston Civic Symphony and the Newton Symphony Orchestra. He is currently a member of the Mercury Orchestra.

EDUCATION

- J.D., Boston College Law School, 2013 (*Senior Editor, Boston College Law Review*)
- B.A., Bowdoin College, 2008 (*with honors*)

ADMISSIONS

- Bar of Massachusetts

THOUGHT LEADERSHIP POWERED BY HUB

- 3 July 2023, Supreme Court Limits Foreign Reach of US Trademark Law
- 9 June 2023, US Supreme Court Vacates Dog Toy Company's Win in Jack Daniel's Parody Trademark Dispute
- 21 June 2023, US Supreme Court Rules Against Andy Warhol–Foundation in Copyright Fair Use Dispute Over Prince Portrait
- November 2022, November 2022 Accolades
- 30 March 2022, Copyright Dispute Over Andy Warhol's Portraits of Prince Heading to U.S. Supreme Court
- 10 March 2021, When Is an Office Chair Design Famous? U.S. Supreme Court Won't Hear Herman Miller's Trade Dress Appeal Regarding the Eames Chair
- 22 January 2021, "Lettuce Turnip the Beet" Pun on T-Shirts Not Trademark Use, Ninth Circuit Affirms
- 4 September 2020, Can't "Shake It Off" Yet: Court Denies Taylor Swift's Motion to Dismiss Copyright Infringement Lawsuit
- 7 July 2020, U.S. Supreme Court Allows Booking.com to Register Its Domain Name as a Trademark
- 29 April 2020, COVID-19: USPTO Further Extends Certain Filing and Payment Deadlines to June 1, 2020 for those Affected by COVID-19 Outbreak
- 28 April 2020, U.S. Supreme Court Rules Georgia's Official Annotated Code Outside the Scope of Copyright Protection Under "Government Edicts" Doctrine
- 1 April 2020, COVID-19: USPTO Offers 30-Day Extension of Filing and Payment Deadlines to Those Affected by COVID-19 Outbreak
- 27 June 2019, U.S. Supreme Court Strikes Down Ban on "Immoral" or "Scandalous" Trademark Registrations
- 25 June 2019, U.S. Supreme Court strikes down ban on "immoral" or "scandalous" trademark registrations
- 8 April 2019, More Companies Adopting Blockchain Solutions
- 8 April 2019, Fashion & Food Industry Update: More Companies Adopting Blockchain Solutions

- 21 December 2018, Federal Circuit Holds Sending Patent Demand Letters Alone May Subject the Sender to Personal Jurisdiction
- 30 March 2017, Sis-Boom-Bah: U.S. Supreme Court Rules That Cheerleader Uniform Design Elements May Be Eligible for Copyright Protection
- 23 March 2017, U.S. Supreme Court Rules that Cheerleader Uniform Elements May Be Eligible for Copyright Protection
- 19 October 2016, Federal Court Dismisses Suits for Failure to Allege Harm Traceable to Any TCPA Violation
- 27 September 2016, Third Circuit Finds Jurisdiction Despite Anti-Aggregation Rule, Holds TCPA Class Settlement Is Not Covered by Insurance Agreement
- 13 September 2016, Wireless Communications Trade Group Opposes FCC Petition Seeking Declaration That Text Messages Are Subject to the FCC's Open Internet Order
- 28 July 2016, The Ninth Circuit Holds That Subsequent Debt Collectors Must Send FDCPA Validation-of-Debt Notices
- 19 May 2016, Supreme Court Decision on Article III Injury-in-Fact in Spokeo Potentially Impacts Class Certification
- 6 May 2016, Is Social Media Sharing of Sports Clips Copyright Infringement? Recent UK Judicial Clarification and International Implications
- 18 April 2016, Untangling the *Webb* of Arbitrability: The Fourth Circuit Holds That Courts Determine the Availability of Class-Wide Arbitration
- 1 April 2016, A Careful Balancing Act: Second Circuit Requires Debt Collectors to Disclose When a Consumer's Current Balance May Increase Due to Interest and Fees
- 30 March 2016, The Supreme Court Charts a Narrow Course in the Use of Statistical Evidence at Class Certification
- 9 March 2016, Sixth Circuit Finds "Prior Express Consent" in Affirming Dismissal of TCPA Class Action against Healthcare Provider's Debt Collector
- 27 May 2015, Supreme Court Grants Cert. to Consider Whether Offer of Complete Relief Moots TCPA Class Action
- 20 May 2015, S.D.N.Y. Judge Denies Class Certification in Fair Housing Act Suit against Morgan Stanley
- 12 May 2015, Governor Tomblin Signs into Law Significant Amendments to West Virginia Consumer Credit Protection Act
- 5 May 2015, Proposed Arbitration Fairness Act Would Ban Pre-Dispute Arbitration Clauses in Consumer Contracts

- 29 April 2015, *Spokeo, Inc. v. Robins*: U.S. Supreme Court to Consider Whether Plaintiffs Have Standing to Assert a Statutory Violation without Alleging any Actual Harm

NEWS & EVENTS

- 29 January 2024, K&L Gates Leads Novozymes to Trade Secrets Trial Victory
- 23 October 2023, K&L Gates' Intellectual Property Practice, Lawyers Recognized in 2023 *Managing IP* Magazine's "IP Stars"
- 19 December 2022, K&L Gates Adds 40 Lawyers to Firm's Partnership
- 6 October 2022, K&L Gates Recognized in 2022 *Managing IP* Magazine's 'IP Stars'
- 18 August 2022, More Than 350 K&L Gates Lawyers Named Among 2023 Best Lawyers in America, Ones to Watch

AREAS OF FOCUS

- IP Litigation
- Commercial Disputes
- IP Procurement and Portfolio Management
- Technology Transactions and Sourcing

EMERGING ISSUES

- Social Media Law

REPRESENTATIVE EXPERIENCE

- Represented a leading, global specialty retailer in bringing trademark infringement lawsuit against two global clothing brands relating to their use of a Moose design on clothing. Able to leverage global enforcement actions in the U.S., Canada, UK, and EU, resulting in favorable resolution for our client.
- Represented a sugar-free breakfast and snack foods manufacturer in trademark infringement and unfair competition litigation against a competing food manufacturer, resulting in favorable settlement prior to defendant's answer deadline.
- Defended Onia, WeWoreWhat, Danielle Bernstein, Saks 5th Avenue, BOP, and Carbon 38, against trademark and copyright infringement allegations brought by a fashion brand relating to alleged copying of designs used on clothing and other items. After well over a year of contentious litigation, all claims were dismissed with prejudice.

- Defended Victoria's Secret against fitness company's claims of trademark infringement, unfair competition/passing off, and related state law claims relating to Victoria's Secret's use of the words "SWEAT" and "SWEAT ON POINT" in marketing. All claims were dismissed with prejudice.
- Represented National Space Society in defending against photographer's claims of copyright infringement relating to use of a photograph on social media. All claims were dismissed with prejudice.
- Represented grocery chain Mexico Foods, LLC d/b/a El Rancho in its declaratory judgment lawsuit for non-infringement of competitor's design trademark and trade dress. After El Rancho filed a Motion for Judgment on the Pleadings requesting the court to enter judgment in El Rancho's favor based on the facts in the Complaint and that a mere "eyeball" tests shows the trademarks are not confusingly similar. The case was successfully resolved in mediation and all claims were dismissed with prejudice.
- Represented Abercrombie & Fitch Co. in defending a lawsuit brought by pro se plaintiff that named over 25 retail manufacturing defendants, in which plaintiff alleged trademark rights in the terms LOWER EAST SIDE and LES NYC. The case against Abercrombie & Fitch resolved successfully in its favor.